

REMARKS/ARGUMENTS

Reconsideration and allowance of this application are respectfully requested. Currently, claims 2-18 are pending in this application.

Rejection Under 35 U.S.C. §112

Claims 1-10 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant submits that each element recited in the claims has a sufficient antecedent basis. Applicant therefore respectfully requests that the rejection of claims 1-10 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Rejections Under 35 U.S.C. §§ 102 and 103

Claims 1-3 and 8-10 were rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Mikelaitis. Applicant respectfully traverses this rejection with respect to still pending claims 2-3 and 8-10.

For a reference to anticipate a claim, each element must be found, either expressly or under principles of inherency, in the reference. Applicant respectfully submits that Mikelaitis fails to disclose each element of the claimed invention. For example, Applicant submits that Mikelaitis fails to disclose “wherein the exchanging of the call control capability data is carried out prior to initiating call set-up,” as required by claim 2 (now rewritten in independent form).

In contrast to exchanging call control capability data prior to initiating call set-up as required by claim 2, Figure 5.8 of Mikelaitis describes messages which can be transmitted between the terminals after a call has been set-up. There is no communication of information from the destination terminal to the originating terminal in Mikelaitis until after the call has been established.

The Office Action alleges that Section 3.3.3 of Mikelaitis discloses exchanging call control capability data prior to initiating call set-up. Applicant respectfully disagrees. Section 3.3.3 of Mikelaitis merely discloses the transmission of messages between the originating terminal and the network. Section 3.3.3 of Mikelaitis fails to even suggest exchanging call control capability data prior to initiating call set-up.

Although Mikelaitis describes the possibility of an originating terminal sending a “prioritized list of Barrier Server specifications”, these specifications are transmitted only to the network (i.e., the Barrier) and not to the destination terminal. There is no disclosure in Mikelaitis of the originating terminal transmitting call capability data to the destination terminal prior to a call being set-up between the terminals as required by claim 2.

Independent claim 3 requires a first communications terminal initiating an exchange of call control capability data by transmitting the call control capability data for the first communications terminal to a second communications terminal, and the second communications terminal returning an acknowledgement including

call control capability data for the second communications terminal to the request.

Independent claims 8 and 10 require similar limitations. Applicant respectfully submits that Mikelaitis fails to disclose these claimed limitations.

Mikelaitis discloses a call connection procedure which first involves communications only between the originating terminal and the network. In particular, the originating terminal negotiates with the network either by offering a list of requested levels of service or by having the network simply informing the originating terminal of the best it can offer. Secondly, the call connection procedure then involves separate communications only between the network and the destination terminal. In particular, the network contacts the destination terminal and informs it of the proposed type of connection. The destination terminal then checks to see if it is currently compatible with that type of connection or if it can reconfigure itself in some way to become compatible. If the destination is not currently compatible or cannot reconfigure itself to be compatible, the destination terminal simply ignores the call (see Section 5.4.2 of Mikelaitis).

The invention of claim 3 involves the originating terminal (i.e., the "first terminal") sending a message containing its call control capability data and then awaiting a response from the destination terminal setting out its call control capability data. In contrast, Mikelaitis (e.g., sections 5.4. and 5.5 of Mikelaitis specifically identified in the Office Action) describes the set-up of a call as

described above (i.e., without the destination terminal transmitting its call control capability data to the originating terminal or *vice versa*). In Section 5.5 of Mikelaitis, most of the envisioned services to be initiated after call set-up are network provided services rather than services related to the capabilities of the terminals:

Accordingly, Applicant submits that claims 2-10 are not anticipated by Mikelaitis and thus respectfully requests that the rejection of these claims under 35 U.S.C. § 102 be withdrawn.

Claims 4 and 5 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Mikelaitis in view of Katsube (U.S.P. '264). Claims 6 and 7 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Mikelaitis in view of Markgraf et al. (U.S.P. '691, hereinafter "Markgraf"). Since claims 4-5 and 6-7 depend at least indirectly from independent claim 3, Applicant submits that the comments made above with respect to claim 3 and Mikelaitis apply equally to these claims. Neither Katsube nor Markgraf remedies the above deficiencies of Mikelaitis. Applicant therefore respectfully requests that the rejection of claims 4-5 and 6-7 under 35 U.S.C. § 103 be withdrawn.

New Claims:

New claims 11-18 have been added to provide additional protection for the invention. New claims 11, 12, 14 depend from claim 3 and new claims 15 and 16 depend from claims 8 and 10, respectively. Applicant therefore submits that these

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claims are allowable for at least the reasons discussed above with respect to claims 3, 8 and 10. New claim 13 depends from claim 2 and thus Applicant submits that this claim is allowable for at least the reasons discussed above with respect to claim 2.

New claims 17 and 18 require, *inter alia*, "wherein the means for exchanging exchanges the call control capability data prior to when the means for setting initiates setting up the call between the communications terminal and the other communications terminal." Applicant submits that claims 17 and 18 are allowable.

Conclusion:

Applicant believes that this entire application is in condition for allowance and respectfully requests a notice to this effect. If the Examiner has any questions or believes that an interview would further prosecution of this application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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